



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,709	10/18/2001	Andrew C. Gilbert	CF/041	8648

1473 7590 11/30/2005

FISH & NEAVE IP GROUP  
ROPES & GRAY LLP  
1251 AVENUE OF THE AMERICAS FL C3  
NEW YORK, NY 10020-1105

EXAMINER

HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
----------	--------------

3621

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/982,709

Applicant(s)

GILBERT ET AL.

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-75 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-75 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- \* Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Status of Claims***

1. Claims 1-75 have been examined.

***Response to Amendments***

2. To one of ordinary skill, a "two-sided market" is discussed in the context of "market makers" in a bond or stock issue. Therefore, the Examiner is maintaining the 112nd rejection because Applicant's definition is attempting to broaden the term beyond its understood meaning within the art.

Applicant's arguments with respect to claims 1-75 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 1-75 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must

clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999).

The term “two-sided market” in the claims is used to mean “a market where a trader places one order, and, places a second order based on the execution of the first order” (Specification-page 2, lines 20-23), while the accepted meaning is “a market in which both bid and asked sides are firm, such as that which a specialist and others who make a market are required to maintain” (BARRON’S FINANCIAL GUIDES: Dictionary of Finance and Investment Terms). Although the Applicant has amended the claims, one of ordinary skill would still expect the term “two-sided market” in the context of a “market-maker” in stocks or bonds.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Broka et al., U.S. Patent No. 5,809,483.

As per claims 1-75, Broka et al. teach a market trading system comprising:

- receiving a bid command (e.g. data related to a tradable item display) from a trader to buy a first sized item, generating an offer (or bid) value based on the submission of a bid (or offer) command from a trader, generating an offer value for which a second size of the item is to be sold, submitting the two-sided trading command on behalf of the trader comprising the bid and an offer command (e.g. generated offer value) (figure 18a) receiving a confirmation command from the trader to confirm the submission and submitting a bid and offer command in response to the confirmation command from the trader (figure 18a, 19 and 21a)
- using an interactive display, displaying current bid and offer data and receiving a selection of a piece of the bid and offer data as part of the receiving of the bid command (figures 24, 25, and 30; column 16, lines 6-10; column 17, lines 4-14 and 45-67; column/line 19/9-20/6) and selecting a bid (or offer) price from the bid and offer data (i.e. viewing market activity- e.g. bid and offer data, and placing a bid, for example, on a desirable issue at a specific price where the price, or offer, was displayed in the market activity) (figure 18a), displaying the current bid and offer data in a window (figure 20a)

- entering the submission of the bid command via keyboard and using a mouse (column 10, lines 58-63)
- overriding the generated bid and offer size and price (figures 18a, 19 and 21a)
- presenting a second trading interface (figures 19 and 20a) that contains information relating to a two-sided command (figure 18a) and displaying the interface in response to the reception of a bid (or offer) command (figures 19 and 20a; column 14, lines 6-12 and 33-45)
- requesting confirmation of the submission of a two-sided trading command (figure 18a ("ok")) and submitting the command in response to the confirmation on behalf of the trader

Regarding, the generating of "offer values", Broka et al. teach quotes as combination "bids" and "asks" (figure 18a; column 4, lines 52-54). Therefore, the Broka et al. system could be used by "market makers" who are willing to buy and sell a given security at a particular price, "arbitrageurs" seeking to capitalize on price differentials in a security, or market participants executing a trading strategy that involves the simultaneous buying and selling of securities. In each instance, a goal is to turn a profit hence, the second transaction (sell if the initial trade was a buy, or buy if the initial trade was a sale) would be based on

the first as both transactions are in the same security. Further, it is well known to those of ordinary skill in the buying and selling of equities to determine a transaction position, and profitability, based on spreads is old and well known.

Regarding the coloring of bid and offer data, Broka et al. teach denoting a piece of data using an asterisk (column 14, lines 55-60) or "highlight" (figure 20a). It has been held that changing the way the system of Broka et al. indicates a dealer's own quote by changing color, for example, would have been an obvious modification to one of ordinary skill (*In re Seid*, 73 USPQ 431, 433 (CCPA 1947))

Regarding "spread sheets", the use of spreadsheets software (e.g. cells, columns, rows) to prepare bids and offers is old and well-known, therefore it would have been obvious to one of ordinary skill to download data such as current market data (figure 18a) in order to construct a profitable bid/offer strategy. Similarly, displaying data remotely using the internet and its associated technologies (e.g. webpages, html, etc.) is also well known.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Laborde discloses spreads for determining a position in a profitable transaction
- Gutterman et al. disclose using the spread to take buy and sell positions in the same equity
- Harrington et al. (previously cited) teach spreadsheets for calculating a bids and offers
- Borzenko teaches coloring bid and offer data
- "Two-sided Market"- Investopedia.com
- "market maker" and "make a market"-  
[www.morganstanleyindividual.com/customerservice/dictionary](http://www.morganstanleyindividual.com/customerservice/dictionary)

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory



action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (571) 272-6712.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
c/o Technology Center 2100  
Washington, D.C. 20231

or faxed to:

(571) 273-8300 (for formal communications intended for entry and after-final communications),

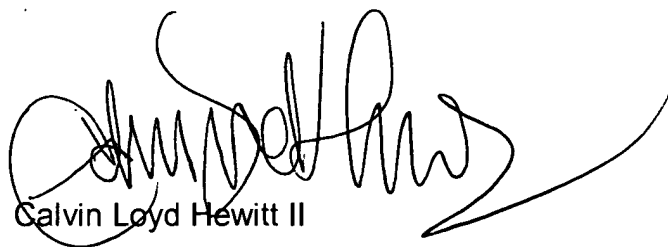
or:

(571) 273-6709 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Application/Control Number: 09/982,709

Page 9

Art Unit: 3621

A handwritten signature in black ink, appearing to read "Calvin Hewitt II", with a large, sweeping flourish extending to the right.

Calvin Loyd Hewitt II

November 14, 2005